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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,808

Applicant(s)

DENNY, LAWRENCE A.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 06/06/03. Claims 1-3 have been amended. Claims 1-3 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al (6,202,923) in view of Kobylevsky et al (6,493,427).

(A) As per claim 1, Boyer discloses a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system, comprising the steps of:
providing electronically a prescription renewal screen by a third party host system to a pharmacy system associated with the pharmacist, the prescription renewal screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

receiving renewal request information from the pharmacy system, the renewal request information identifying a requested renewal of the filled prescription (Col.6, lines 5-67);

transmitting the renewal request information through the host system to a health care provider system associated with a health care provider identified by the filled prescription stored on the host system (Col.6, lines 1-67).

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Boyer does not explicitly disclose receiving, by the host system, an authorization from the health care provider system authorizing the requested renewal of the filled prescription;

transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient.

However, these features are known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests receiving, by the host system, an authorization from the health care provider system authorizing the requested renewal of the filled prescription; transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient (Col.7, lines 10-67 to Col.8, line 34 and Col.29, lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled (See Kobylevsky, Col.2, lines 50-67).

(B) As per claim 2, Boyer discloses a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system, comprising the steps of:

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providing electronically a prescription renewal screen by a third party host system to a pharmacy system associated with the pharmacist, the prescription renewal screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

receiving renewal request information from the pharmacy system, the renewal request information identifying a requested refill of the filled prescription, and a prescription renewal authorization obtained from a health care provider authorizing the requested renewal of the filled prescription (Col.6, lines 5-67).

Boyer does not explicitly disclose generating a verification of the requested renewal by the host system including a unique prescription identification code identifying the requested renewal whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient.

However, this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested renewal by the host system including a unique prescription identification code identifying the requested renewal whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient (See Kobylevsky Col.7, lines 1-67 to Col.8, line 34 and Col.29, lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled (See Kobylevsky, Col.2, lines 50-67).

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(C) As per claim 3, Boyer discloses a method for permitting a health care provider to verify a renewal of a filled prescription stored on a host system, comprising the steps of: providing electronically a prescription renewal screen by a third party host system to a health care provider system associated with the health care provider, the prescription renewal screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

receiving renewal request information from the health care provider, the renewal request information identifying a requested renewal of the filled prescription, and a prescription renewal authorization authorizing the request renewal of the filled prescription (Col.6, lines 5-67).

Boyer does not explicitly disclose generating a verification of the requested renewal by the host system including a unique prescription identification code identifying the requested renewal whereby a pharmacist associated with a pharmacy system is authorized to provide the renewal of the filled prescription to the patient .

However, this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested renewal by the host system including a unique prescription identification code identifying the requested renewal whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient (See Kobylevsky Col.7, lines 1-67 to Col.8, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the

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motivation of providing the prescription which is authorized to be refilled (See Kobylevsky, Col.2, lines 50-67).

Response to Arguments

4. Applicant's arguments filed 06/06/03 regarding claims 1-3 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 06/06/03.

(A) At pages 18-19 of the 06/06/03 response, Applicant admitted and stated:

(1) "a refill" is a prescription drug that is provided again. Well known in the art, there are two ways a subsequent prescription drug is a continuation drug can be provided to a patient... This also known in the art as a refill, but it is known and more clearly identified in the art as a renewal prescription".

(2) At pages 20-29 of the 06/06/03 response, Applicant argues "it is respectfully submitted that Boyer and Kobylevsky, whether viewed alone or in combination, do not teach, disclose or even suggest a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system as recited in Applicant's independent claims 1 and 2".

(3) Applicant argues in claim 3, "neither Boyer nor Kobylevsky teach, disclose, or suggest providing electronically a prescription renewal screen by a third party host system to a pharmacy system, receiving by the receiving renewal request information from the pharmacy system, transmitting the renewal request information through the host system to a health care provider system, receiving, by the host system, an

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authorization from the health care provider system authorizing the requested renewal of the filled prescription from the health care provider system, and transmitting by the host system the authorization to the pharmacy system".

(4) In addition, Applicant argues "neither Boyer nor Kobylevsky teach, disclose, or suggest a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system by providing electronically a prescription renewal screen by a third party host system to a pharmacy system, receiving renewal request information from the pharmacy system and a prescription renewal authorization authorizing the requested renewal of the filled prescription obtained from a health care provider, and generating a verification of the requested renewal by the host system including a unique prescription identification code".

(5) Further, Applicant argues "neither Boyer nor Kobylevsky teach, disclose, or suggest a method for permitting a health care provider to verify a renewal of a filled prescription stored on a host system by providing electronically a prescription renewal screen by a third party host system to a health care provider system, receiving renewal request information from the health care provider and a prescription renewal authorization authorizing the request renewal of the filled prescription and generating a verification of the requested renewal by the host system including a unique prescription identification code.

(6) Furthermore, Applicant argues that "even assuming that it would be obvious to modify Boyer and Kobylevsky, in addition to the other deficiencies of Boyer as discussed above, such a combination would not result in the invention recited in

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Applicant's amended claims 1-3. Therefore, it is Applicant's position that all of the limitations of amended claims 1-3 are not found in the combination of Boyer and Kobylevsky.

With respect to Applicant first argument, Examiner respectfully agrees with this assertion since Applicant acknowledges that "refill" is known in the art as a form of "renewal". Therefore, Examiner has been anticipated and thanked the Applicant for it.

With regard to Applicant second argument through sixth argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 3). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time

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of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinary skill in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the Boyer and Kobylevsky references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 06/06/03 amendment, have been fully addressed by the Examiner as either being disclosed by or obvious in view of the collective teachings of Boyer and Kobylevsky based on the logic and sound scientific reasoning of one of ordinary skill in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method and apparatus for integrated management of pharmaceutical and healthcare services (6,112,182), on-line pharmacy automated refill system (5,970,462), interactive medication ordering system (5,758,095) and automated method for filling rug prescriptions (5,883,370).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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V.F
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August 22, 2003

Alexander Calinowski
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AU 3626
PATENT EXAMINER